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09/910,184	07/20/2001	Joseph Porat	205,073	1503

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EXAMINER

STINSON, FRANKIE L

ART UNIT

PAPER NUMBER

1746

DATE MAILED: 10/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/910,184

Applicant(s)

PORAT, JOSEPH

Examiner

FRANKIE L. STINSON

Art Unit

1746

-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14, 18-24, 27, 29 and 30 is/are rejected.
- 7) ☒ Claim(s) 15-17, 25, 26 and 28 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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1. The indicated allowability of claims 19-23 is withdrawn in view of the newly discovered reference(s) to Ward et al. Waclawik et al. and Kissinger. Rejections based on the newly cited reference(s) follow.

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the spherical element and ball bearing as claimed in claim 7, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 7 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 7 recites a "spherical element" however the specification is absent any mention of this limitation.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 4-14, 24, 27, 29 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Minami et al. (U. S. Pat. No. 5,435,03) in views of Wulc.

Re claim 1, Minami is cited disclosing an automated power-driven pool cleaning apparatus for cleaning the walls of the pool comprising a programmable control device, a motion translating member (42) for contacting the surface of the wall, a signal transmitting member (44), and a sensor (142) mounted to receive the transmitted signal where the control device changes the direction of movement when apparatus has not moved that differs from the claim only in the recitation of the control device being programmed to change a direction of movement of the apparatus when the output of the sensor indicates the apparatus has not move in a *prescribed period of time*. Wulc is cited disclosing in a pool cleaning apparatus the arrangement of a programmable control device being programmed to change the direction of movement of the apparatus after a prescribed period of time (see the pause/halt step as at col.8, lines 19-24 and col.9 line 74-75). It therefore would have been obvious to one having ordinary skill in the art to modify the device of Minami, to include the prescribed period of time as taught by Minami for the purpose of preventing damage to the apparatus. Re claim 4, Minami discloses the translating member being a wheel. Re claim 5, Minami discloses the translating member being in contact with the wall surface. Re claim 6, no patentable distinction is deemed to exist between the material as claimed and the material as taught by Minami. This is also applicable to the spherical element as claimed in claim 7 and the corresponding structure in either Minami or Wulc, as for what was understood.

Re claim 8, Minami discloses the signal transmitter being mounted on the wheel. Re claim 9, Minami discloses the signal transmitter being mounted to rotate with the wheel. Re claim 10, Minami discloses the transmitter mounted on the periphery of the wheel. Re claim 11, Minami discloses the sensor mounted to receive or not receive the signal in dependence upon a rotational position of the wheel. Re claim 12, Minami discloses the sensor being mounted at a position such that the signal transmitter is alternately proximate and distance as the wheel rotates. Re claim 13, Minami discloses the magnet mounted on the periphery of the wheel. Re claim 14, Minami discloses the reed switch (110). Re claims 24, 27 and 29, Minami discloses the signal transmitter being a light element (see col. 12, lines 55-68). Re claim 30, no patentable distinction is deemed to exist between the time period of 5 seconds as claimed and the time pause/halt interval timer as taught by Wulc.

7. Claims 18-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Minami et al. in view of Wulc as applied to claim 1 above, and further in view of either Ward et al. or Kissinger or Waclawik et al.

Claim 18 defines over the applied prior art only in the recitation of the support assembly for urging the motion translation member to the surface of the wall being cleaned. Ward, Kissinger and Waclawik are each disclosing in a motion-translating member, an assembly for urging said motion-translating member to a surface. It therefore would have been obvious to one having ordinary skill in the art to modify the apparatus of Minami, to include an urging assembly as taught by either Ward, Kissinger or Waclawik, for the purpose of ensuring proper contact of the motion translating member to the

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surface of the pool walls. Re claim 19, Ward, Kissinger and Waclawik disclose the spring-biased shaft. Re claim 20, Ward, Kissinger and Waclawik disclose the mounting bracket. Re claim 21, ward, Kissinger and Waclawik disclose the wheel. Re claims 22 and 23, to have the motion-bearing member in the shape of a sphere or a continuous belt, is deemed to be an obvious substitution of equivalents (see MPEP 2144.06, "Art Recognized Equivalence for the Same Purpose").

8. Claims 15-17, 25, 26 and 28 stand objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. In Phillips, Sommer, Midkiff, Petersen, Zeidler et al., Moini, Rief and Erlich'434, note the cleaning/detecting means.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to FRANKIE L. STINSON whose telephone number is (703) 308-0661. The examiner can normally be reached during the first week of the pay-period M-F from 5:30 a.m. to 3:00 p.m. and during the second week of the pay-period from Tu-Th second from 5:30 a.m. to 3:00 p.m. and on Fri. from 5:30 a.m. to 2:00 p.m. Alternating Mondays off.

The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9310 (NON-FINAL REJECTION STATUS) and (703) 872-9311 (AFTER-FINAL REJECTION STATUS).

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Any inquiry for missing parts of this Office Action (copies of references, pages, forms etc.), contact Office Manager Ms. Sandra Sewell (703) 308-0661.

fls



FRANKIE L. STINSON
Primary Examiner
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